

REMARKS

In the Office Action,¹ the Examiner rejected claims 1-3, 5, and 6 under 35 U.S.C. § 103(a) as being unpatentable over Shimomura (U.S. Patent No. 6,539,310, "Shimomura") in view of Kawanishi et al. (JP No. 11-123182, "Kawanishi") and in further view of Fukuda et al. (U.S. Patent No. 6,393,317, "Fukuda").

By the present amendment, Applicant has amended claims 1 and 3. Support for the amendments can be found at, for example, page 8, lines 8-10 of Applicant's specification.

Applicant respectfully traverses the rejection of claims 1-3, 5, and 6 under 35 U.S.C. § 103(a) over Shimomura in view of Kawanishi and Fukuda. No *prima facie* case of obviousness is established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries...[include determining the scope and content of the prior art and]...[a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

The cited references, taken alone or in combination, fail to teach or suggest each and every element of amended claim 1. For example, the cited references fail to teach or suggest, at least, “means for calculating at least one of values of bone weight and muscular weight of the body on the basis of the measured impedance and said personal information put into the display equipment” (emphasis added), as recited in amended claim 1.

The Examiner concedes that “for claims 1-3, 5, and 6, Shimomura in view of Kawanishi discloses the claimed invention, as set forth and cited above, except for expressly disclosing (b) the means for calculating at least one value of bone weight, water weight, and muscular weight of the body on the basis of the measured impedance and said personal information.” Office Action at page 5.

The Examiner further states that “Fukuda teaches (b) the means for calculating (50) at least one value of water weight of the body on the basis of the measured impedance and said personal information (column 7 lines 9-35).” Office Action at page 5.

Fukuda discloses that “[i]n addition, the impedance measurement is performed again, but with the change in frequency of the high frequency current, and ‘Cole-Cole plot law’ is applied to the measurement results. Then, the amount of intracellular or extracellular fluid as well as the water content in each of the parts of the body can be derived.” Col. 7, lines 24-29 (emphasis added). Thus, Fukuda appears to teach measuring impedance twice with different frequency and applying “Cole-Cole plot law” to the measured results to derive water content in each part of the body. However, Fukuda fails to teach or suggest “means for calculating at least one of values of bone weight and muscular weight of the body on the basis of the measured impedance and said personal information put into the display equipment” (emphasis added), as recited in amended claim 1. Therefore, Fukuda does not cure the deficiencies of Shimomura and Kawanishi, identified by the Examiner.

For at least the above reasons, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 1. Accordingly, no reason has been clearly articulated as to why claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1.

Therefore, amended independent claim 1 should be allowable, and claims 2, 3, 5, and 6 should also be allowable due to their direct or indirect dependence from claim 1.

In view of the foregoing remarks, Applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

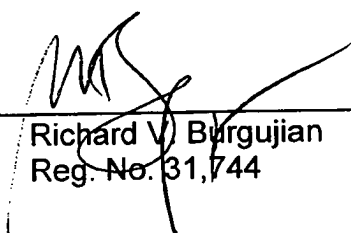
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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